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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,236	07/31/2003	Julie Baker	84595CPK	1733
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			EXAMINER SCHWARTZ, PAMELA R	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 10/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/631,236	BAKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Pamela R. Schwartz	1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-7, 9-13 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7, 9-13, 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1794

1. The finality of the last office action is withdrawn in view of the following rejections.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6, 10-13 and 16-21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,929,824. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are to a method of making an article (disclosed in the specification as being an inkjet print medium. The method recites a support and a coating of hydrophilic polymer and blowing agent with the blowing agent being activated as part of the process. Therefore, by practicing the method, the hydrophilic polymer will inherently be porous and foamed and the functional language of claims 16 and 21 will also be inherently met. It would have been considered obvious to one of ordinary skill in this art to form multiple layers of the same

Art Unit: 1794

or different composition in order to increase the overall thickness or to vary the size of pores throughout the thickness to control ink absorption characteristics. Since a support is recited in the claims, it is proper to look to the specification to determine what the support may be and the supports recited by the patent may be the same as those of claim 6. Determination of the proportion of blowing agent to hydrophilic polymer would have been obvious to one of ordinary skill in the art in order to control the size and frequency of pore formation in the polymer.

3. Claims 4-7, 9-13 and 16-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/545,406. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are to a method of making a material comprising a support and a coating containing a polymer, surfactant and blowing agent. Therefore, by practicing the method, the hydrophilic polymer will inherently be porous and foamed and the functional language of claims 16 and 21 will also be inherently met. It would have been considered obvious to one of ordinary skill in this art to form multiple layers of the same or different composition in order to increase the overall thickness or to vary the size of pores throughout the thickness to control ink absorption characteristics. Identifying claimed elements in the specification, the material is an inkjet print medium, the support is may be as recited by claim 6 [0022], and the resin is hydrophilic [0023]. The surfactant is not disclosed, but it would have been obvious to use conventional surfactants in conventional proportions since a surfactant is recited by the copending claims. In

Art Unit: 1794

addition, determination of the proportion of blowing agent to obtain layers with desired pore sizes and frequencies would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 6, 10-13 and 16-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/551916. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a method of making a material and an ink jet receiver. The material is formed from a foamed hydrophilic polymer that is foamed using a blowing agent. The polymer solution is coated onto a support. By practicing the method, the hydrophilic polymer will inherently be porous and foamed and the functional language of claims 16 and 21 will also be inherently met. It would have been considered obvious to one of ordinary skill in this art to form multiple layers of the same or different composition in order to increase the overall thickness or to vary the size of pores throughout the thickness to control ink absorption characteristics. Since a support is recited in the claims, it is proper to look to the specification to determine what the support may be and the supports recited by the patent may be the same as those of claim 6 [0058]. Determination of the proportion of blowing agent to hydrophilic polymer would have been obvious to one of ordinary skill in the art in order to control the size and frequency of pore formation in the polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 3, 5, 6, 10-13 and 16-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of copending Application No. 10/436,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are directed to an imaging element wherein the image receiving layer is an open celled foam. The layer is formed from a polymer and a blowing agent (claims 4 and 6). The medium may be an ink jet receiver (cl. 24). Turning to the specification for more information about the support, the support may be as recited by instant claim 6 [0090]. The medium may have multiple ink receiving layers (cl. 23). The medium may include a crosslinking agent (cl 15-17). The polymer may be polyvinyl alcohol which is inherently hydrophilic (cl. 6) which will inherently be porous and foamed and the functional language of claims 16 and 21 will also be inherently met. It would have been considered obvious to one of ordinary skill in this art to form multiple layers of the same or different composition in order to increase the overall thickness or to vary the size of pores throughout the thickness to control ink absorption characteristics. Determination of the proportion of blowing agent to hydrophilic polymer would have been obvious to one of ordinary skill in the art in order to control the size and frequency of pore formation in the polymer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. All prior grounds of rejection have been overcome.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz  
October 26, 2007

  
PAMELA R. SCHWARTZ  
PRIMARY EXAMINER